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10/727,224	12/03/2003	Asit Dan	YOR920020340US1	5193
48813	7590	11/10/2009		
LAW OFFICE OF IDO TUCHMAN (YOR)			EXAMINER	
ECM #72212			LIM, KRISNA	
PO Box 4668				
New York, NY 10163-4668				
			ART UNIT	PAPER NUMBER
			2453	
			NOTIFICATION DATE	DELIVERY MODE
			11/10/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pair@tuchmanlaw.com

# Office Action Summary

## Application No.

10/727,224

## Applicant(s)

DAN ET AL.

## Examiner

Krisna Lim

## Art Unit

2453

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

1. Claims 1-2 and 4-31 are still pending for examination, and claim 3 was canceled.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

3. Claims 1-2 and 4-31 are still rejected under 35 U.S.C. §102(e) as being anticipated by Van Dordick et al.[U.S. Patent No. 2004/0230459]. This reference has been used in the last two office action.

4. Dordick et al. anticipates (e.g., see Figs. 1-3B) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference anticipates a method for embedding an agreement (110) between a device provider (104) and a device user (106) in a device (e.g., last line of paragraph 42, a system), the method comprising:

a) storing the agreement as computer readable code in the device (e.g., see the agreement 110 of 1 in the e-business environment (see paragraph 34) with the electronic payment option (see paragraph 35), moreover this feature is known in the art as admitted by the applicant; see page 4, line 27 of applicants' specification);

b) monitoring (308-312 of Fig. 3A) at least one performance parameter (e.g., insurance risk metric); and

b) determining if an event specified in the agreement has occurred based on the parameter (e.g., see 314 of Fig. 3B).

5. As to claim 2, Dordick et al. further anticipates if the event occurred indicating that the event occurred at the device (e.g., see 314 of Fig. 3B).
6. As to claim 4, Dordick et al. further anticipates enforcing the agreement at the device (e.g., translating policies into actions, see first 5 lines of paragraph 42, or their ability to satisfy various kinds of service level agreement, see paragraph 34).
7. As to claim 5, Dordick et al. further anticipates enforcing the agreement includes disabling at least some of the capabilities of the device if the event occurred (e.g., in the event that the service fails to meet recited quality standard, see paragraph 20).
8. As to claim 6, Dordick et al. further anticipates enforcing the agreement includes enabling at least some of the capabilities of the device if the event occurred (e.g., see 316 of Fig. 3B).
9. As to claim 7, Dordick et al. further anticipates representing the agreement as a Boolean expression (e.g., the use of logical operation to implement the operations, steps or modules which is a matter of choice, see paragraphs 32 and 33) of at least one condition, the condition based on the parameter.
10. As to claim 8, Dordick et al. further anticipates the event is a violation of the agreement (e.g., in the event that the service fails to meet recited quality standard, see paragraph 20).
11. As to claim 9, Dordick et al. further anticipates indicating violation of the agreement on the device (e.g., in the event that the service fails to meet recited quality standard, see paragraph 20).

12. As to claim 10, Dordick et al. further anticipates informing the device provider of the event occurrence (e.g., compensate insurance purchaser for loss, see 316 of Fig. 3B).
13. As to claim 11, Dordick et al. further anticipates restricting access to parameter data (e.g., see paragraph 39).
14. As to claim 12, Dordick et al. further anticipates receiving the parameter data by manual entry (e.g., see paragraph 36).
15. As to claim 13, Dordick et al. further anticipates transmitting the parameter data to the device provider (e.g., see paragraph 36).
16. Claims 14-31 are rejected for the same rationale as claims 1-2, 4-13, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited references.
17. Applicant's arguments, the applicant's remark, filed 7/7/09, with respect to the rejection(s) of claim(s) 1-2, and 4-31 under Dordick et al. have been fully considered, but the rejection is respectfully maintained with some modification to clarify the citation portion of the reference as indicated above.

Throughout the argument, applicant kept citing the portion of the reference that the Examiner referred to and stated that the citation did not teach the claimed language. Given the broadest interpretation of the claimed language and the applicant's responsibility to understand the whole the reference, not just the portion of the citation

by the examiner, Examiner still believes that the claimed language is not patentable over the Dordick as clearly clarified in the above rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Art Unit: 2453

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

November 05, 2009

/Krisna Lim/

Primary Examiner, Art Unit 2453